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09/918,279	07/30/2001	Evan John Kaye	3092/1G780-US1	2407

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EXAMINER

WON, MICHAEL YOUNG

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/918,279

Applicant(s)

KAYE, EVAN JOHN

Examiner

Michael Y. Won

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This action is responsive to the amendment filed March 21, 2005.
2. Claim 1 has been amended. Claims 1-21 have been re-examined and are pending with this action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3. Claims 1-21 have been rejected under 35 U.S.C. 102(e) as being anticipated by Chui et al. (US 6,657,702 B1).

As per **claim 1**, Chui teaches a method for facilitating purchases gift items that are made available for purchase from a host server, comprising the steps of: a) retrieving at least a set of names of potential gift recipients from an address book (see column 18, lines 10-18) maintained on a client machine (see column 17, lines 64-66); b) combining into a selection form at the client machine one or more gift items available through the host server and the set of names of the potential gift recipients (see column 17, lines 21-25 and column 18, lines 4-39); and c) forwarding to the host server a portion of the address book contents which concerns the set of names after the names have been combined into the selection form (inherent: see column 17, lines 55-63).

As per **claim 2**, Chui further teaches of including the additional step of enabling a user at the client machine to associate SER items with potential gift recipients and thereby define a set of intended gift recipients (see column 3, lines 13-15).

As per **claim 3**, Chui further teaches of including the additional step of enabling the user at the client machine to associate a message with a potential gift recipient (see column 3, lines 13-15).

As per **claim 4**, Chui further teaches wherein the message is entered by the user (see Fig.5, #522; column 11, lines 30-35; and column 15, lines 40-45).

As per **claim 5**, Chui further teaches wherein plural messages can be entered by the user, and wherein the user can select any one of the plural

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messages for associating with a particular recipient in the set of potential gift recipients (see Fig.5, #522; column 11, lines 30-35; and column 15, lines 40-45).

As per **claim 6**, Chui further teaches wherein plural messages are displayed at the client machine, any one of which is associable with a particular recipient in the set of potential gift recipients (see Fig.5, #522; column 11, lines 30-35; and column 15, lines 40-45).

As per **claim 7**, Chui further teaches wherein the selection form further includes the at least one message which the user is enabled to associate with the potential gift recipient (see Fig.5, #522; column 11, lines 30-35; and column 15, lines 40-45).

As per **claim 8**, Chui further teaches wherein the association of gift items with potential gift recipients is made by selecting a radio button, which is displayed at the client machine (see column 16, lines 40-48).

As per **claim 9**, Chui further teaches wherein the association of gift items with potential gift recipients is made by selecting a checkbox, which is displayed at the client machine (see column 18, lines 20-24).

As per **claim 10**, Chui further teaches of including the additional step, once the set of intended gift recipients has been defined, of presenting at the client machine a shipping form which is automatically populated with the names and shipping information for each of the intended gift recipients, the shipping information including an address which is retrieved from the address book (see column 18, lines 4-39).

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As per **claim 11**, Chui further teaches of including the additional step of providing the names and shipping information of the intended gift recipients to the host server (see column 18, lines 4-24).

As per **claim 12**, Chui further teaches wherein the shipping information for at least one of the intended gift recipients is populated in the shipping form free of manual entry by the user (see column 18, lines 4-24).

As per **claim 13**, Chui further teaches wherein, prior to the retrieving step, a user provides permission to access the address book (see column 23, lines 1-23).

As per **claim 14**, Chui further teaches wherein the address book is retrieved from the client machine (see column 23, lines 1-23).

As per **claim 15**, Chui further teaches wherein the address book is retrieved from a third party server (see column 23, lines 1-23).

As per **claim 16**, Chui further teaches of including the additional step of executing a component at the client machine which performs steps (a) and (b) (see column 18, lines 4-24 and column 23, lines 1-23).

As per **claim 17**, Chui further teaches wherein the selection form displays, for each name in the set of potential gift recipients, any prior gift item associations that were made in a previous session with the host server so as to advise a user of a possible repeat gift item purchase (see column 18, lines 25-55).

As per **claim 18**, Chui teaches a method for facilitating purchases of gift items made available for purchase by a host server, comprising the steps of: a)

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downloading to a client machine a component from the host server (see Fig.5 and column 18, lines 4-25), the component including a selection template which coordinates with information in an address book which is accessible from the client machine (see column 17, lines 64-66 and column 18, lines 4-25 & 43-47); b) retrieving into the component at least a set of names of potential gift recipients from the address book (see Fig.3B and column 18, lines 10-18); c) retrieving from the host server a set of gift items, each of which is associable with one or more names in the set of potential gift recipients (see Fig.7B; Fig.7C; and column 18, 4-39); d) displaying in a browser operating at the client machine a matrix of selection cells which is defined by intersecting rows and columns, one of the rows and columns denoting the set of gift items and the other denoting the names in the set of potential gift recipients (see Fig.7B; Fig.7C; and column 18, lines 25-45); and e) enabling the user to associate names in the set of potential gift recipients with gifts in the set of gift items by interacting with one or more selection cells to thereby define a set of intended gift recipients (see Fig.8, #804; column 17, lines 21-25; and column 18, lines 13-24).

As per **claim 19**, Chui further teaches of including the additional step of providing the set of intended gift recipients to the host server free of manual entry of the names of the intended gift recipients (see column 18, lines 10-40).

As per **claim 20**, Chui further teaches wherein the interaction with the selection cells comprises selecting a radio button (see column 16, lines 40-48).

As per **claim 21**, Chui further teaches wherein the interaction with the selection cells comprises selecting a check box (see column 18, 20-24).

***Response to Arguments***

4. Applicant(s) argues in substance regarding claim 1, that Chui does not teach of “utilizing an address book maintained on the user’s client machine”, but rather the address book is maintained at the server machine. The examiner disagrees with this assertion. Clearly, Chui teaches against this assertion in column 17, lines 64-66 that “information used to fulfill an order could be collected from the user in the first instance and maintained in a data repository located at the user’s client system”. Furthermore, Chui welcomes any alternative “mechanism or technique for identifying recipients” (see column 18, lines 19-20).

With respect to the arguments regarding claim 18, specifically that Chui does not teach “downloading and use of components at the client machine”, the examiner suggests the applicant(s) to turn to Fig.5. Clearly Fig.5 teaches of a web browser (Microsoft Internet Explorer). Such web documents are inherently downloaded to the user/client machine so that the user/client may navigate via the hyperlinks (icons or text). The components within the web page direct, inform or assist the user to establish an image-alias association (see column 17, lines 20-25). Fig.5 clearly and explicitly teach the above limitation and therefore claim 18 remain rejected.



***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

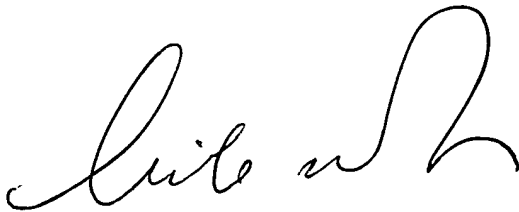
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

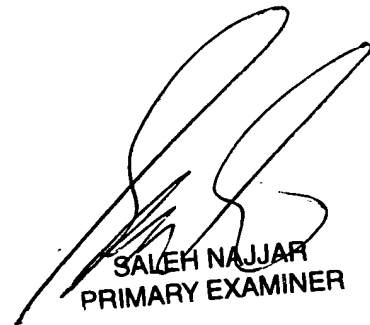
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Won



July 14, 2005

  
SALEH NAJJAR  
PRIMARY EXAMINER